

Applicants: Heribert LORENZ et al.  
Application No. 10/730,469  
Amendment in Response to Office Action dated October 5, 2004

#### REMARKS

Applicants respectfully requests reconsideration and allowance of this application in view of the amendments above and the following comments.

Claims 1 – 2 are pending. New claim 2 has been added. It is supported by originally filed claim 1 and page 2, lines 18-21 of the instant specification. Amendments have been made to claim 1 to overcome the rejection under 35 U.S.C. 103. Support for the amendment to claim 1 is supported by page 2, lines 18-21 of the instant specification. Changes that have been made to the claims are presented above using strikethrough, underlining, and double-brackets. It is believed that no new matter has been added.

Since this amendment is being filed along with a Request for Continued Examination (RCE), no showing under 37 CFR § 1.116(b) is believed to be required.

#### Rejections under 35 U.S.C. 103

The Examiner rejected claim 1 under 35 U.S.C. 103(a) as being obvious over Andousset (U.S. Patent No. 5,578,087) in view of Rose et al. (U.S. Patent No. 4,003,699). The Examiner found Andousset to generally teach a hair dyeing composition comprising at least one benzimidazole component combined with developing agents. The Examiner concedes the reference does not teach the compounds claimed in claim 1b). According to the Examiner, Rose teaches a hair-dyeing formulation comprising 3-

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morpholinophenol. The Examiner found it would have been obvious to modify the composition of Andousset by incorporating 3-morpholinophenol of Rose to obtain the instantly claimed composition.

In response, Applicant points out that obviousness can only be established by combining or modifying the teachings of the prior art to produce the claimed invention where there is some teaching, suggestion, or motivation to do so either explicitly or implicitly in the references themselves or in the knowledge generally available to one of ordinary skill in the art. *See* MPEP §2143.01. Applicants submit a person skilled in the art would not have been led to the instant invention, because Andousset, the primary reference relied on by the Examiner, clearly requires at least one benzimidazole component. In fact, Andousset teaches away from the Applicants' invention, as the reference requires that the composition additionally contain a benzimidazole component. As the focus of Andousset is on the novel effect of the benzimidazole component, a person skilled in the art would simply not look to this reference for a specific combination of the components chosen from the listed coupling/developing agents. Applicants point out that the benzimidazole component is clearly excluded from the instant claim as evidenced by the transitional phrase "consisting of" prior to the recitation of the claim elements. Rose does not remedy the defect in the teaching of Andousset, and even so, Rose is not relied upon by the Examiner for this purpose. Therefore, Applicants submit the claim is not rendered obvious by the combination of Andousset and Rose.

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In addition, Applicants submit that new claim 2 is not rendered obvious by Andousset in combination with Rose, because a person skilled in the art would not have looked to them to obtain the instantly claimed combination. This is evident by the Examiner who relied upon Rose to teach the 3-morpholinophenol component, which is clearly not recited in the instant claim 2. For reasons set forth above with respect to claim 1, claim 2 is not rendered obvious by Andousset in combination with Rose.

In view of the foregoing, Applicants submits that the Examiner would be fully justified to reconsider and to withdraw this rejection. An early notice that this rejection has been reconsidered and withdrawn is, therefore, earnestly solicited.

#### Conclusion

Applicants believe that the foregoing constitutes a bona fide response to all outstanding objections and rejections.

Applicants also believe that this application is in condition for immediate allowance. However, should any issue(s) of a minor nature remain, the Examiner is respectfully requested to telephone the undersigned at telephone number (212) 808-0700 so that the issue(s) might be promptly resolved.

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Early and favorable action is earnestly solicited.

CONDITIONAL PETITION FOR EXTENSION OF TIME

If entry and consideration of the amendments above requires an extension of time, Applicants respectfully request that this be considered a petition therefor. The Commissioner is authorized to charge any fee(s) due in this connection to Deposit Account No. 14-1263.

ADDITIONAL FEE

Please charge any insufficiency of fees, or credit any excess, to Deposit Account No. 14-1263.

Respectfully submitted,

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By 

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